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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,236	06/19/2002	Jens Iver Find	FIND=1	1698

1444 7590 06/13/2003

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EXAMINER

KRAWCZEWCZ MYERS, LOUANNE C

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 06/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/088,236	FIND, JENS IVER
	Examiner Louanne C Krawcz wicz Myers	Art Unit 1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-10, 12, 14-22, 27, 28, 31-33, 36, 38 and 39 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-10, 14-22, 27, 28, 31, 32, 38 and 39 is/are allowed.
- 6) Claim(s) 12, 33 and 36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

*LK Myers*

## DETAILED ACTION

### Priority

The priority claimed in the preliminary amendment (paper no. 5, received 5/17/02) needs to be amended. The recitation set forth currently is inaccurate. Instead of the following recitation, "This application is a 371 of PCT/DK00/00522, filed September 20, 2000, published in English, which is a non-provisional of 60/161,938, filed October 28, 1999", it appears that the following -- This application is the national stage of PCT/DK00/00522, filed September 20, 2000, published in English, which claims benefit of US provisional application no. 60/161,938, filed October 28, 1999 -- would be more accurate. Correction is necessary.

### 35 USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 12 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is confusing. It is suggested that Applicant use standard Markush claim language. Also, it appears that the following anti-auxin compounds have been misspelled: page 30, line 16 "–naphthalene", page 30, line 24 "dichlorophenoxyactic" and page 30, line 28 "naptalam". It appears that these same compounds have been

spelled similarly in the specification on page 8, lines 24-32 and page 9, line 1.

Correction and/or clarification are necessary.

Claim 36 is indefinite because it depends on cancelled claims 34 and 35.

### **Claim Rejections - 35 USC § 102/103**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33 and 36 are rejected under 35 U.S.C. 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Becwar et al. Claim 33 is drawn to a conifer embryo having a water content less than 70%. Becwar et al disclose the preparation of pine somatic embryos "for germination by a maturation drying treatment which reduced their water content by an average of about 50%" (column 19, lines 63-67). The disclosed pine embryos of Becwar et al appear to meet the limits of

claim 33. Thus, the claimed invention is clearly *prima facie* obvious over, if not anticipated by, the prior art.

Claim 36 states a conifer plant produced from an embryo. Becwar et al teach the production of "328.... vigorously growing somatic embryo plants" (column 21, lines 45-46) by somatic embryogenesis. The claimed plant appears to be the same as the plants produced by Becwar et al. Thus, the claimed invention is clearly *prima facie* obvious over, if not anticipated by, the prior art. The courts have approved the use of 102/103 rejections for product-by-process claims. See MPEP 2113.

#### **Reference Cited**

Kebebew et al is cited but not applied in any rejection herein and is made of record to exemplify the closest prior art known to the examiner similar to the Applicant's method. However, since Kebebew et al teach somatic embryogenesis of tef, *Eragrostis tef*, there is no reasonable expectation to use this method in conifers.

#### **Conclusion**

Claims 1-10,14-22, 27, 28, 31, 32, 38 and 39 are allowed.

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louanne C. Krawczewicz Myers whose telephone number is (703) 305-5166. The examiner can normally be reached on Monday and Thursday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (703) 308-4205. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications, (703) 872-9306 for Before Final communications, (703) 872-9307 for After Final communications and (703) 872-9305 for Customer Service. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

LKM

XKM

*Bruce Campell*  
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